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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,088	02/15/2002	Jean-Michel Marchon	88265-6488	3491
29157	7590	05/26/2005	EXAMINER	
BELL, BOYD & LLOYD LLC			MADSEN, ROBERT A	
P. O. BOX 1135			ART UNIT	
CHICAGO, IL 60690-1135			PAPER NUMBER	

1761

DATE MAILED: 05/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/077,088

Applicant(s)

MARCHON ET AL.

Examiner

Robert Madsen

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 May 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☒ Applicant's reply has overcome the following rejection(s): The rejection of claim 23 under 35 USC 112, 1st paragraph.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 1-9 and 21-27.

Claim(s) withdrawn from consideration: None.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☒ Other: See attached response to arguments.

DETAILED ACTION

1. The amendment filed May 9, 2005 under 37 CFR 1.116 in reply to the final rejection will be entered upon the filing of an appeal, but is not deemed to place the application in condition for allowance. Upon the filing of an appeal and entry of the amendment, the status of the claims would be as follows:

Allowed claim(s): none

Rejected claim(s): 1-9,21-27

Claim(s) objected to: none

2. The specific rejection of claim 23 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement has been withdrawn in light of the amendment.

Response to Arguments

3. With respect to claim 1, in particular, Applicant asserts that the phrase "substantially lacks rough edges and forming tool marks" is described in the specification because (1) substantially can be another term for essentially and (2) the specification clearly teaches the round frozen confectionery can substantially or essentially lack rough edges and forming tool marks.

First, the issue addressed in the rejection was made under 35 U.S.C 112, first paragraph, was not whether substantially *can* be another term for essentially, but rather

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the originally filed specification reasonably conveyed to one of ordinary skill in the art a round item of frozen confectionery that "substantially lacks rough edges and forming tool marks". The originally filed specification is directed to a frozen confectionery that "essentially lacks an apex, rough edges and forming tool marks" and has a round surface that is smooth and defect-free so that it can be sold as an uncoated product (Page 2, line 34 to Page 3, line 3, Page 3, lines 19-25, Page 4, second paragraph). The "Technical Field" portion of the specification describes having a protuberance in the form of a tip, or an apex, is a defect and must be sold as a coated product (Page 2, lines 11-19). The originally filed specification does not reasonably convey that applicant had possession of a round item of frozen confectionery that "substantially lacks rough edges and forming tool marks" as recited in claim 1 at the time the application was filed because the claim does not exclude an apex. According to the originally filed specification, products with an apex are not defect free and cannot be sold as uncoated products, which is the intention of Applicant's invention.

4. Regarding claim 21, Applicant contends that the originally filed specification supports the limitations that the frozen confectionery can substantially or essentially lack an apex. As discussed above, the originally filed specification disclose to a frozen confectionery that "essentially lacks an apex, rough edges and forming tool marks".

5. With respect to Miura and Raitt, Applicant's contend the determination of cohesion requires more than simply the height of the ice cream after being formed in a scoop. Applicant defined cohesion as "the percentage ratio between the height of an item just before hardening and that at the outlet of the extrusion nozzles" (Page 4,

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Paragraph 2). Thus, Miura and Raitt meet the limitation of greater than 95% cohesion, as defined in the specification, because the ice cream is extruded into a mold for hardening and, therefore, the height of the ice cream ball is not reduced prior to hardening relative to the height because its goes directly from the outlet of the extrusion nozzle to fill the mold and no deformation would occur.

6. Applicant further contend that the frozen confectionery of Miura does not “substantially lack rough edges and forming tool marks”. Miura teaches ice cream balls that are *coated* to “nearly spherical” shapes, and as evidenced by the admission of the prior art, coating will mask surface flaws to create a round appearance. It is noted that claim 1 does not exclude *coated* frozen confectioneries, and thus Miura meets the “substantially lack rough edges and forming tool marks” limitation.

7. Applicant further contend that the frozen confectionery of Raitt does not “substantially lack rough edges and forming tool marks”. Raitt meet the limitation by providing ice cream balls in mold halves with a plastic strips between the molds and around/inside the ice cream balls where a forming mark is normally seen. It is noted that claim 1 does not exclude *packaged* frozen confectioneries, and as presented by Raitt in the package, the ice creams balls “substantially lack rough edges and forming tool marks”.


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Conclusion


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Madsen whose telephone number is (571) 272-1402. The examiner can normally be reached on 7:00AM-3:30PM M-F.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert Madsen 
Examiner
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